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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,094	09/15/2000	Eric Schneider		3485

24226	7590	01/14/2004

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EXAMINER
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ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 December 2003</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>18-33</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>18-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u>.

4)☐ Interview Summary (PTO-413) Paper No(s). _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

Detailed Action

Status of Claims:

Claims 18-33 are pending in this Office Action.

Claims 1-17 are canceled.

Claims 18-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement.

Response to Arguments

Applicant's arguments filed in the amendment filed December 1, 2003, Paper No. 4, have been

fully considered but they are not persuasive. The reasons are set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

Applicants specification is rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter, which

was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. Applicant's amendment A on page 2, replacing the first paragraph from page

18, lines 1-18 cites new matter. Applicant replaces the pronoun it with "an unpublished identifier

that can potentially correspond to a network resource having information that is scheduled to be

publicly released" cites new matter in the keywords "unpublished identifier." The examiner can

find no mention of the phrase "unpublished identifier" in applicant's unamended specification.

Claims 18-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter, which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Applicant uses the phrase "unpublished identifier" which is not found in the accepted

specification.

The phrase is used in the independent claims 18, line 2; claim 32, line 6; claim 33, line 3.

Applicant's invention as claimed:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-22, 30-33 are rejected under U.S.C. 102(e) as being anticipated by U.S. Patent

Number 5,978,828 by Greer et al.

Regarding claim 18, a method for providing notification of newly released public

information (Greer: col. 1, lines 51-60, lines 31-34) comprising:

ascertaining at a time that an unpublished identifier can potentially correspond to a

network resource having information that is scheduled to be publicly released after said time

(Greer: col. 7, lines 51-67), wherein said unpublished identifier does not correspond to said

network resource at said time (Greer: col. 7, lines 51-67);

determining after said time whether said information can be accessed from said network

resource corresponding to said unpublished identifier (Greer: col. 8, lines 30-38); and

providing notification that said information can be accessed from said network resource

when it is determined that said information can be accessed from said network resource

corresponding to said unpublished identifier (Greer: col. 8, lines 61-64).

Regarding claim 19, the method as set forth in claim 18, wherein said ascertaining at said

time that said unpublished identifier can potentially correspond to said network resource includes

selecting a tithe access method from one of a retrieval method (Greer: col. 7, lines 23-33),

generation method (Greer: col. 4, lines 3-6), and input method (Greer: col. 7, lines 63-67).

Regarding claim 20, the method as set forth in claim 19, wherein said generation method

includes generating a starting time from said unpublished identifier (Greer: col. 4, lines 3-6).

Regarding claim 21, the method as set forth in claim 19, wherein said retrieval method

includes retrieving a starting time from user modifiable configuration settings (Greer: col. 7,

lines 23-33).

Regarding claim 22, the method as set forth in claim 18, wherein said determining after

said time whether said information can be accessed from said network resource corresponding to

said unpublished identifier includes performing a resource access request from said unpublished identifier (Greer: col. 1, lines 50-60; col. 2, lines 61-65).

Regarding claim 30, the method, as set forth in claim 18, wherein said unpublished identifier is an unpublished uniform resource locator (URL) having at least one URL component (Greer: col. 1, lines 22-25).

Regarding claim 31, the method, as set forth in claim 30, wherein said URL component includes one of a year, month, week, day, time, and publishing interval (Greer: col. 8, lines 1-8).

Regarding claim 32, an apparatus for providing notification of newly released public information comprising (Greer: col. 1, lines 51-60, lines 31-34):

a processor (Greer: col. 2, lines 25-47);

a memory in operative association with said processor (Greer: col. 2, lines 25-47);

means for retrieving content from a computer network (Greer: col. 2, lines 25-47);

means for ascertaining at a time that an unpublished identifier can potentially correspond to a network resource having information that is scheduled to be publicly released after said time (Greer: col. 7, lines 51-67), wherein said unpublished identifier does not correspond to said network resource at said time (Greer: col. 7, lines 51-67);

means for determining after said time whether said information can be accessed from said network resource corresponding to said unpublished identifier (Greer: col. 8, lines 30-38); and

means for providing notification that said information can be accessed from said network resource when it is determined that said information can be accessed from said network resource corresponding to said unpublished identifier (Greer: col. 8, lines 61-64).

Regarding claim 33, a computer program product for providing notification of newly released public information comprising computer readable program code stored on a computer readable medium (Greer: col. 2, lines 25-47), the program code adapted to execute the method for ascertaining at a time that an unpublished identifier can potentially correspond to a network resource having information that is scheduled to be publicly released after said time (Greer: col.

7, lines 51-67), wherein said unpublished identifier does not correspond to said network resource at said time (Greer: col. 7, lines 51-67), determining after said time whether said information can be accessed from said network resource corresponding to said unpublished identifier (Greer: col. 8, lines 30-38), and providing notification that said information can be accessed from said network resource when it is determined that said information can be accessed from said network resource corresponding to said unpublished identifier (Greer: col. 8, lines 61-64).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,978,828 by Greer at al in view of U.S. Patent Number 5,933,604 by Inakoshi. (Applicant IDS)

Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,978,828 by Greer at al in view of U.S. Patent Number 5,933,604 by Inakoshi (Applicant IDS) in further view of U.S. Patent Number 5,790,790 by Smith et al (Applicant IDS).

Regarding claim 23,

The Greer reference teaches a system for notifying a user about a change in a tagged or bookmarked site.

The Greer reference does not discuss different methods of requesting resources.

Inakoshi teaches the method as set forth in claim 22, wherein said resource access request includes a differencing resource method (Inakoshi: col. 5, lines 64-67; col. 6, lines 1-4).

Inakoshi further teaches that this method prevents confusion of protocols when matching each of a variety of means of communication individually and it becomes easy to support newly introduced means of communications (Inakoshi: col. 6, lines 13-18).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the system of notification taught (Greer: Abstract) by Greer and incorporate different methods of requesting resources (Inakoshi: col. 5, lines 64-67; col. 6, lines 1-4) as taught by Inakoshi in an effort to prevent confusion of protocols when matching each variety of means of communication individually and easily support newly introduced means of communications (Inakoshi: col. 6, lines 13-18).

Claims 24 and 25 are rejected under the same rationale given above. In the rejections set fourth, the examiner will address the additional limitations and point to the relevant teachings of Greer et al and Inakoshi

Regarding claim 24, the method as set forth in claim 23, wherein said differencing resource method includes comparing the difference from one of a plurality of file dates, file sizes, and number of files counts froth a directory (Inakoshi: col. 12, lines 1-13).

Regarding claim 25, the method as set forth in claim 18, wherein said providing notification that said information can he accessed from said network resource includes providing notification from one of a hyperlink access (Inakoshi: col. 3, lines 1-5; col. 5, lines 5-11) and automatic access (Greer: col. 3, lines 14-20; Inakoshi: col. 5, lines 28 and 29).

Regarding claim 26,

The Greer reference teaches a system for notifying a user about a change in a tagged or bookmarked site. The Greer reference does not discuss different methods of requesting resources. The Inakoshi reference teaches a hyperlink generation method (Inakoshi: col. 3, lines 1-5). The Inakoshi reference does not detail how the user of the system selects hyperlink access.

Smith teaches a system wherein said hyperlink access includes selecting said hyperlink from one of a hyperlink determination method (Smith: col. 4, lines 10-14) and hyperlink retrieval method (Smith: col. 4, lines 10-14).

Smith further teaches that its client/server architecture provides a better extensibility than a more pipelined structure. It also decouples the store clients from each other, which can be useful in the context where some tasks are interactive, while others are more background oriented (Smith: col. 4, lines 14-20).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the system of notification (Greer: col. 1, lines 51-60, lines 31-34) taught by Greer with different methods of requesting resources (Inakoshi: col. 6, lines 13-18) as taught by Inakoshi while incorporating a method of selecting different hyperlink access (Smith: col. 4, lines 10-14) as taunt by Smith in order to provide better extensibility and decouple the clients from each other allowing for more background orientation of clients (Smith: col. 4, lines 14-20).

Claims 27 – 29 are rejected under the same rationale given above. In the rejections set fourth, the examiner will address the additional limitations and point to the relevant teachings of Greer et al and Inakoshi and Smith et al.

Regarding claim 27, the method as set forth in claim 26, wherein said hyperlink determination method includes selecting said differencing resource method, generating at least one hyperlink corresponding to the accessible network resource from said differencing resource method selection (Smith: col. 4, lines 10-14, 20-47), and providing said notification having said hyperlink (Smith: col. 8, lines 37-41).

Regarding claim 28, the method, as set forth in claim 27, wherein said providing said notification includes selecting a notification method corresponding to a subscriber (Smith: col. 4, lines 10-14; the account manager).

Regarding claim 29, the method, as set forth in claim 28, wherein said selecting said notification method includes selecting a notification destination from one of a pager, e-mail, web page, television, phone, fax, instant message, and conferencing (Smith: col. 4, lines 10-14).

The Applicant Argues:

Applicant argues that the Greer et al reference teaches a system of providing notification of a content change of a web page that relies of the existence of the web page. Applicant argues that Greer relies on an existing network resource corresponding to an identifier that has changed and that it is not applicable in this case because applicant does not teach providing notification when an existing web page no longer exists.

In response, the examiner respectfully submits:

The Greer reference does teach a notification system (Greer: col. 8, lines 26, 27) that signals when modifications or updates are made to a page (Greer: col. 7, lines 63-67).

Applicant's specification cites "the identifier may be a URI and the resource corresponding to the identifier may not exist or exist intermittently" on page 21, paragraph 3 of the specification.

Accordingly, these form the basis of the rejection for the following dependent claims 19-31 that are not patentably distinguishable over the relevant references cited.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

U.S. Patent Number 6,105,098 by Ninose et al;

U.S. Patent Number 6,003,061 by Jones et al;

U.S. Patent Number 6,038,601 by Lambert et al;

U.S. Patent Number 5,995,594 by Shaffer et al;

U.S. Patent Number 5,109,486 by Seymour;

U.S. Patent Number 5,404,231 by Bloomfield;

Berners-Lee et al, Uniform Resouce Identifiers (URI): Gener Syntax, Network Working Group,

Xerox Corporation, August 1998. http://www.ietf.org/rfc/rfc2396.txt

U.S. Patent Number 5,813,007 by Nielson;

U.S. Patent Number 6,519,568 by Harvey et al;

U.S. Patent Number 6,502,132 by Kumano et al; and

U.S. Patent Number 6,332,141 by Gonzalez et al;

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin R Bruckart whose telephone number is (703) 305-

0324. The examiner can normally be reached on 8:00-5:30PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the

organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-0324.

Benjamin R Bruckart
Examiner
Art Unit 2155
brb
January 5, 2004

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER